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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/352,976	07/14/1999	MICHAEL D. GILBERT	00169-027001	2851
26161	7590	04/22/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			CHANG, VICTOR S	
			ART UNIT	PAPER NUMBER

1771

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/352,976

Applicant(s)

GILBERT, MICHAEL D.

Examiner

Victor S Chang

Art Unit

1771

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached NOTE.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,4-6,8,9,14-26,28-30 and 32.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300 1700

Daniel Zinker

NOTE

1. Applicants' amendment to claims 1, 5, 8 and 14, and cancellation of claims 2, 3, 7, 10-13, 27, 31 and 33-65 have been entered, so as to place the Application in better form for appeal by materially reducing or simplifying the issues for appeal.

2. It is noted that the newly amended claim 1 now recites in part "said matrix functionality comprises an epoxy, and said electrolyte functionality comprises an electrolyte additive selected from the group consisting of ion solvating molecules ...".

The Examiner notes that while the scope of the matrix functionality has been clarified to partially overcome the prior rejection (see Paper No. 112603, pages 4-6) under 35 U.S.C. 112, first and second paragraphs, the amendment is still insufficient to clarify the unobviousness of the instantly claimed composition. In particular, in view of the preamble of claim 1, which only recites "A composition", the Examiner notes that the scope of the claimed subject matter is still deemed to be unduly broad. As such, if further prosecution, i.e., a CPA or RCE, is contemplated, the Examiner notes that further clarification of claimed subject matter is required, such as a Declaration with comparative data to distinguish the adhesive strength between the instant invention from Moulton's composition may help to clarify the point of novelty and/or nonobviousness, as suggested in an interview on 4/22/2003.

3. With respect to Applicants' argument that "nowhere does Moulton disclose or suggest the particular compositions covered by the claims as amended. In particular, Moulton does not disclose or suggest compositions that include an epoxy and also

Art Unit: 1771

include an electrolyte additive selected from ion solvating molecules ..." (Remarks, bottom paragraph), the Examiner repeats (see Paper No. 18, pages 4-5) that Moulton expressly teaches that suitable cathode prepolymers are well known in the art ... include ... propylene oxide, ethylene oxide, epichlorohydrin etc. (column 12, lines 26-35). Further, Moulton also teaches that a composite cathode can comprise a compatible cathodic material, a conductive material, an electrolytic solvent, an alkali salt, and a solid matrix forming polymer (column 8, lines 10-21). As such, Moulton's teachings clearly reads upon the scope of the subject matter of instant independent claim 1, Applicants' argument to the contrary notwithstanding.